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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,882	09/19/2001	Wilhelm Ernst Riedl	PTU 000001	9853

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EXAMINER	
PEREZ GUTIERREZ, RAFAEL	
ART UNIT	**PAPER NUMBER**
2686	

DATE MAILED: 09/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/955,882	Riedl et al.	
	Examiner	Art Unit	
	Rafael Perez-Gutierrez	2686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 April 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *25 April 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This Action is in response to Applicant's amendment filed on April 25, 2005. **Claims 1-25** are still pending in the present application. **This Action is made FINAL.**

Drawings

2. The replacement drawings received on April 25, 2005 have been accepted by the Examiner.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office Action:

> A person shall be entitled to a patent unless -- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11-17 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by **Hotto (U.S. Patent # 5,410,541)**.

Consider **claims 11-13 and 16**, Hotto also discloses a cellular (cordless) telephone device (e.g., cellular (cordless) telephone instrument (unit) or cellular (cordless) telephone switching facility (base station)) (figure 1, column 3 line 20 - column 4 line 11, and column 5 lines 45-53), comprising:

an audio circuit (not shown) which produces an analog signal from an audible voice

signal during a cellular (cordless) telephone call (column 3 lines 24-40);

a first modulator (e.g., a frequency shift keying (FSK) modulator producing an FSK signal) which modulates a carrier with digital data to produce a digitally modulated signal (column 3 lines 53-60);

an adder 10 (summer circuit) which sums the analog signal and the digitally modulated signal to produce a composite analog and digital signal (figure 1 and column 3 lines 45-47 and 60-66);

a second modulator (e.g., means for imposing) which modulates a radio frequency (RF) carrier with the composite analog and digital signal to produce a modulated RF carrier (column 5 lines 53-63); and

a transmitter (e.g., means for imposing and transmitting) which transmits the modulated RF carrier (column 5 lines 53-63).

Consider **claims 14 and 15**, and **as applied to claim 11 above**, Hotto further discloses that the digital data comprise caller identification (ID) data (text message data) for visual display (column 1 lines 15-30, column 3 lines 41-60, and column 4 lines 12-38).

Consider **claim 17**, and **as applied to claim 11 above**, Hotto also discloses that the audio circuit (not shown) produces an analog signal having frequencies within the range 500-5,000 Hz and the first modulator (e.g., FSK modulator produces a digitally modulated signal having a nominal frequency within the range 10-30 KHz since the frequencies can be arbitrarily selected) (column 3 lines 53-60 and column 5 lines 29-42).

Claim 25 is similarly rejected for the same reasons explained in detail above for **claims**

11, 12, 14-16 and below for **claims 18, 19, and 21-23**.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the Examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the Examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. **Claims 1-10 and 18-24** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hotto (U.S. Patent # 5,410,541)** in view of **Schley-May (U.S. Patent # 6,169,792 B1)**.

Consider **claim 1**, Hotto clearly discloses a method of simultaneously communicating voice and data in a cellular (cordless) telephone system (column 5 lines 46-53), the method comprising the acts of:

generating an analog signal from an audible voice signal during a cellular (cordless) telephone call (abstract and column 3 lines 27-40);

generating a digitally modulated signal from digital data during the cellular (cordless) telephone call (abstract and column 3 lines 41-60);

summing the analog signal and the digitally modulated signal to produce a composite analog and digital signal (abstract and column 3 lines 45-47 and 60-64);

modulating a radio frequency (RF) carrier with the composite analog and digital signal to produce a modulated RF carrier (column 5 lines 53-63); and

transmitting the modulated RF carrier (column 5 lines 53-63).

Hotto further discloses that the digital signal could be of in any number of different frequencies and can be transferred using different pairs of frequencies arbitrarily selected (column 5 lines 29-40).

However, Hotto does not specifically sets the nominal frequency of said digital signal to be within the range of 10 KHz to 30 KHz.

In the same field of endeavor, Schley-May discloses a method for transferring a caller ID (ANI) data signal in which the nominal frequency of said data signal can be within the range of

100 Hz to 10 KHz (abstract, figures 7 and 8, and column 8 lines 22-40).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to select a nominal frequency of 10 KHz for the data signal as taught by Schley-May in the method of Hotto for the purpose of eliminating undesirable signal attenuation.

Consider **claims 2 and 3**, and **as applied to claim 1 above**, Hotto, as modified by Schley-May, further discloses that the digital data comprise caller identification (ID) data (text message data) for visual display (column 1 lines 15-30 and column 3 lines 41-60).

Consider **claim 4**, and **as applied to claim 1 above**, Hotto, as modified by Schley-May, also discloses that the act of generating the digitally modulated signal comprises generating a frequency shift keying (FSK) signal (column 3 lines 53-58).

Consider **claim 5**, and **as applied to claim 1 above**, Hotto, as modified by Schley-May, further discloses that the act of generating the analog signal comprises generating an analog signal having frequencies within the range 500-5,000 Hz (column 5 lines 29-42).

Consider **claim 6**, Hotto also discloses a method of simultaneously communicating voice and data in a cellular (cordless) telephone system (column 5 lines 46-53), the method comprising the acts of:

receiving a modulated radio frequency (RF) carrier during a cellular (cordless) telephone call (column 3 lines 1-4, column 4 lines 43-59, and column 5 lines 53-63);

demodulating the modulated RF carrier to produce a composite analog and digital signal (column 4 lines 43-59 and column 5 lines 53-63);

filtering the composite analog and digital signal to separate an analog signal and a

digitally modulated signal from one another (column 5 lines 1-13);

producing an audible voice signal from the analog signal (column 4 line 39 - column 5 line 28); and

detecting digital data from the digitally modulated signal and processing the digital data for display or control in the cellular (cordless) telephone system (column 1 lines 15-30 and column 4 line 39 - column 5 line 28).

Hotto further discloses that the digital signal could be of in any number of different frequencies and can be transferred using different pairs of frequencies arbitrarily selected (column 5 lines 29-40).

However, Hotto does not specifically sets the nominal frequency of said digital signal to be within the range of 10 KHz to 30 KHz.

In the same field of endeavor, Schley-May discloses a method for transferring a caller ID (ANI) data signal in which the nominal frequency of said data signal can be within the range of 100 Hz to 10 KHz (abstract, figures 7 and 8, and column 8 lines 22-40).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to select a nominal frequency of 10 KHz for the data signal as taught by Schley-May in the method of Hotto for the purpose of eliminating undesirable signal attenuation.

Consider **claims 7 and 8**, and **as applied to claim 6 above**, Hotto, as modified by Schley-May, further discloses that the digital data comprise caller identification (ID) data (text message data) for visual display (column 1 lines 15-30, column 3 lines 41-60, and column 4 lines 12-38).

Consider **claim 9**, and **as applied to claim 6 above**, Hotto, as modified by Schley-May, also discloses that the act of detecting digital data comprises detecting digital data from a frequency shift keying (FSK) signal (column 3 lines 53-58 and column 5 lines 1-13).

Consider **claim 10**, and **as applied to claim 6 above**, Hotto, as modified by Schley-May, further discloses that the analog signal has frequencies within the range 500-5,000 Hz (column 5 lines 29-42).

Consider **claims 18-20 and 23**, Hotto further discloses a cellular (cordless) telephone device (e.g., cellular (cordless) telephone instrument (unit) or cellular (cordless) telephone switching facility (base station)) (figures 1 and 2, column 4 line 12 - column 5 line 13, and column 5 lines 45-53), comprising:

means for receiving (receiver) which receives a modulated radio frequency (RF) carrier during a cellular (cordless) telephone call (column 5 lines 53-63);

means for detecting (demodulator which demodulates) the modulated RF carrier to produce a composite analog and digital signal (column 5 lines 53-63);

a filter 14 which filters the composite analog and digital signal to separate an analog signal and a digitally modulated signal from one another (figure 2, column 4 lines 17-25 and 59-65, and column 5 lines 1-13);

a speech network 16 (audio circuit with speaker) which produces an audible voice signal from the analog signal (figure 2 and column 4 lines 17-21);

an analog interface 20 (detector) which detects digital data from the digitally modulated signal that comprises a frequency shift keying (FSK) signal (figure 2, column 3 lines 53-60, and

column 4 lines 43-59); and

a digital signal processor (DSP) 22 which processes the digital data for display or control in the cellular (cordless) telephone device (figure 2 and column 4 lines 39-65);

wherein the speech network 16 (audio circuit with speaker) remains unmuted during receipt of the digital data (column 2 lines 18-27).

However, Hotto does not specifically sets the nominal frequency of said digital signal to be within the range of 10 KHz to 30 KHz.

In the same field of endeavor, Schley-May discloses an apparatus for transferring a caller ID (ANI) data signal in which the nominal frequency of said data signal can be within the range of 100 Hz to 10 KHz (abstract, figures 7 and 8, and column 8 lines 22-40).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to select a nominal frequency of 10 KHz for the data signal as taught by Schley-May in the device of Hotto for the purpose of eliminating undesirable signal attenuation.

Consider **claims 21 and 22**, and **as applied to claim 18 above**, Hotto, as modified by Schley-May, also discloses that the digital data comprise caller identification (ID) data (text message data) for visual display (column 1 lines 15-30, column 3 lines 41-60, and column 4 lines 12-38).

Consider **claim 24**, and **as applied to claim 18 above**, Hotto, as modified by Schley-May, further discloses that the analog signal has frequencies within the range 500-5,000 Hz (column 5 lines 29-42).

Response to Arguments

6. Applicant's arguments with respect to **claims 1, 6, and 18** have been considered but are moot in view of the new ground(s) of rejection.

7. Applicant's arguments filed on April 25, 2005 have been fully considered but they are not persuasive.

Regarding **claim 11**, Applicant argues, on page 14 and 15 of the remarks, that Hotto does not disclose a first and second modulator as claimed.

The Examiner respectfully disagrees because Hotto clearly discloses that two modulators are required for RF transmission of the information in the form of a frequency shift keying (FSK) modulator producing an FSK signal which modulates a carrier with digital data to produce the digitally modulated signal (column 3 lines 53-60) and a second modulator (e.g., the means for imposing) which modulates a radio frequency (RF) carrier with the composite analog and digital signal to produce a modulated RF carrier (column 5 lines 53-63).

Regarding **claim 25**, Applicant argues, on page 15 of the remarks, that Hotto does not disclose a transmitting portion and a receiving portion.

The Examiner respectfully disagrees with Applicant's argument because Hotto clearly discloses means for transmitting the RF composite signal as well as means for receiving said RF composite signal in column 5 lines 46-63.

Therefore, in view of the above reasons and having addressed each of Applicant's arguments, the previous rejection for claims 11 and 25 is maintained and made FINAL by the

Examiner.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any response to this Office Action should be **faxed to** (571) 273-8300 **or mailed to**:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rafael Perez-Gutierrez whose telephone number is (571) 272-7915. The Examiner can normally be reached on Monday-Thursday from 6:30am to 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Marsha D. Banks-Harold can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

Rafael Perez-Gutierrez

R.P.G./rpg

RAFAEL PEREZ-GUTIERREZ
PRIMARY EXAMINER

September 23, 2005